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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,810	01/16/2006	Junichiro Sugita	115990-004	3340
24573	7590	06/13/2008		
BELF., BOYD & LLOYD, LLP			EXAMINER	
P.O. Box 1135			HESS, BRUCE H	
CHICAGO, IL 60690				
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			06/13/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,810

Applicant(s)

SUGITA ET AL.

Examiner

Bruce H. Hess

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claims 1-4 are again rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent 7,074,741 in view of any of the patents to Hirota et al. (JP 03-162991), Mori et al. (JP 05-330257), Josa et al. (JP 09-234963) or Simpson et al. (JP 10-157310) for the reasons of record.

Applicants' assertion to the contrary, the motivation to combine separately taught prior art anti-sticking agents (i.e., block copolymer silicone resin and phenoxy resin) resides in the fact that the aforementioned compounds perform the same function. In re Crockett, 126 USPQ 186. It is logical that such a combination would not only produce the same effect but would supplement each other. In re Crockett, supra.

Applicants' argument with respect to priority would be valid only if a terminal disclaimer of the present application had been filed in the later filed patent upon which double patenting is based. See MPEP 1490, V.D. No such terminal disclaimer was filed in U.S. Patent 7,074,741.

2. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Yokoyama et al. (JP 10-297123) in view of any of the patents to Hirota et al., Mori et al., Josa et al. or Simpson et al. for the reasons of record.

As noted above, the motivation to combine separately taught prior art anti-sticking agents (i.e., block copolymer silicone resin and phenoxy resin) resides in the fact that the aforementioned compounds perform the same function. In re Crockett, 126 USPQ 186. It is logical that such a combination would not only produce the same effect but would supplement each other. In re Crockett, supra.

Applicants' assertion to the contrary, the results listed in Table 2 fail to establish that unexpected results have been obtained with the claimed combination of block copolymer silicone resin and phenoxy resin anti-sticking agents since the separate materials were not tested alone in the same total amount of anti-sticking agents as employed in representative Example 1.

3. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

4. /Bruce H Hess/

Primary Examiner, Art Unit 1794 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce H. Hess whose telephone number is (571)-272-1525. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571)-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bruce H Hess
Primary Examiner
Art Unit 1794

/Bruce H Hess/
Primary Examiner, Art Unit 1794